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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,960	03/22/2001	Tatsuya Uchikata	NEG-201US	2849
466	7590	07/28/2004	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			WINTER, JOHN M	
			ART UNIT	PAPER NUMBER

3621

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/813,960

Applicant(s)

UCHIKATA, TATSUYA

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 26 is/are rejected.
- 7) ☒ Claim(s) 12-25,27,28 and 30-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/9/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-28 and 30-31, drawn to a transaction method utilizing identifiers, classified in class 705, subclass 61
- II. Claim 29 and 32, drawn to a program for use on a transaction apparatus, comprising a cooling off period., classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because extending the cooling off period, as stated in invention II has no dependency on a system for making transactions as stated in invention I. The subcombination has separate utility such as extending the cooling off period.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via the paper filed on May 24, 2004 the applicant has elected the examination of invention I directed towards claims 1-28, 30 and 31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29 and 32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-28, 30 and 31 have been examined

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Patent 6,249,772) in view of Hogan (US Patent 5,704,046).

As per claim 1,

Walker et al ('772) discloses a transaction method comprising the steps  
sending a second identifier associated with the first identifier and a part of the transaction information to a vendor's terminal;(Column 11, lines 7-17)

sending a notification to said buyer's terminal in response to an instruction indicating that goods, to which the second identifier is attached, have been delivered to a retail store, the goods being obtained by referencing the part of the transaction information and being sold the transaction;(Column 11, lines 18-49)

checking to see if there is a correspondence between the identifiers upon receiving the first identifier received by a buyer and the second identifier attached to the delivered goods (figure 8B)

outputting an instruction allowing the delivered goods to be passed to the buyer if there is the correspondence (Figure 8B)

sending an instruction requesting to transfer an amount for the goods from a buyer's account to a predetermined account.(Column 11, lines 41-49)

Walker et al ('772) does not explicitly disclose assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction, sending the first identifier to said buyer's terminal Hogan et al. ('046) discloses assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction, sending the first identifier to said buyer's terminal. (Figure 3). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al ('772) method with the Hogan. ('046) program in order to keep a persistent record of unique customers for profiling purposes.

As per claim 2,

Walker et al ('772) discloses a transaction method as defined by claim 1 wherein at least one of sending the first identifier, sending the second identifier, sending the part of the transaction information, and sending the notification is done via electronic email.(Column 10, lines 24-34)

As per claim 3,

Walker et al ('772) discloses a transaction apparatus comprising:

sending a second identifier associated with the first identifier and a part of the transaction information to a vendor's terminal;(Column 11, lines 7-17)

means for sending a notification to said buyer's terminal response to an instruction indicating that goods, to which the second identifier is attached, have been delivered to a retail store, the goods being obtained by referencing the part of the transaction information and being sold in the transaction;(Column 11, lines 18-49)

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means for correspondence checking to see if there is a between the first identifiers upon receiving the identifier received by a buyer and the second identifier attached to the delivered goods;(figure 8B)

means for outputting an instruction allowing the delivered goods to be passed to the buyer there is the correspondence;(Figure 8B)

means for sending an instruction requesting to transfer an amount for the goods from a predetermined account to a vendor's account.(Column 11, lines 41-49)

Walker et al ('772) does not explicitly disclose means for assigning a first identifier, termed as "first identifier", to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; means for sending the first identifier to said buyers terminal Hogan et al. ('046) discloses means for assigning a first identifier, termed as "first identifier", to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; means for sending the first identifier to said buyers terminal. (Figure 3). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al ('772) method with the Hogan. ('046) program in order to keep a persistent record of unique customers for profiling purposes.

As per claim 4,

Walker et al ('772) discloses the transaction apparatus as defined by claim 3

wherein said means for sending an instruction requesting to transfer the amount for the goods to the vendor's account sends an instruction to request to transfer the amount for goods from an account of the buyer to the vendor's account retail store specified.(Column 11, lines 41-49)

As per claim 5,

Walker et al ('772) discloses the transaction apparatus as defined by claim 2 wherein said means for sending an instruction requesting to transfer the amount for the goods to the vendor's account sends an instruction to request to transfer the amount for the goods from an account of a delivery service provider to the vendor's account, the delivery service provider delivering the goods. (Column 11, lines 41-60)

As per claim 6,

Walker et al ('772) discloses a transaction method comprising the steps of:

sending a second identifier associated with the first identifier and a part of the transaction information to a vendor's terminal;(Column 11, lines 18-49)

attaching, by a vendor, the second identifier to goods which is obtained by referencing the part of the transaction information and which will be sold in the transaction;(Column 11, lines 18-49)

passing the goods, via retail store or directly, to a delivery service provider;(Column 11, lines 50-60 )

searching for, by the delivery service provider, a retail store specified by a buyer and delivering the goods to the retail store;(Figure 6A)

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sending a notification to said buyer's terminal in response to the second identifier entered from a terminal at the retail store, the second identifier being attached to the goods;(Column 11, lines 18-49)

checking to see if there is a correspondence between the first identifier recorded on a recording medium taken by a buyer and the second identifier attached to the delivered goods; (figure 8B)

passing the delivered goods to the buyer there the correspondence;(Figure 8B)

transferring an amount for the delivered goods from a buyer's account to a vendor's account.(Column 11, lines 41-49)

Walker et al ('772) does not explicitly disclose assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal Hogan et al. ('046) discloses assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal. (Figure 3). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al ('772) method with the Hogan. ('046) program in order to keep a persistent record of unique customers for profiling purposes.

As per claim 7,

Walker et al ('772) discloses a transaction method comprising the steps of:

sending a second identifier associated with the first identifier and a part of the transaction information to a vendor's terminal;(Column 11, lines 18-49)

attaching, by a vendor, the second identifier to goods which is obtained by referencing the part of the transaction information and which will be sold in the transaction;(Column 11, lines 18-49)

passing the goods, via a retail store or directly to a delivery service provider; (Column 11, lines 50-60 )

searching for, by the delivery service provider, a buyer and delivering the goods to the buyer;(Figure 6A)

checking a correspondance between the buyer's identifier and the second indetifier attached to the delivered goods and giving an instruction, via a portable terminal, to transfer an amount for the delivered goods from a delivery service provider s account to a vendor s account.(Column 11, lines 41-49)

Walker et al ('772) does not explicitly disclose assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal. Hogan et al. ('046) discloses assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal. (Figure 3). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al ('772) method with the Hogan. ('046) program in order to keep a persistent record of unique customers for profiling purposes.

As per claim 8,

Walker et al ('772) discloses a transaction method comprising the steps of:

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checking to see if there is a correspondence between the first identifier held by the buyer and the second identifier attached to the delivered goods and, (Column 11, lines 18-49) there is the information sent from a buyer's terminal, the transaction information relating to a transaction; (Figure 8B)

sending a second identifier associated with the first identifier and a part of the transaction information to a vendor's terminal; (Column 11, lines 7-17)

sending a notification to said buyer's terminal in response to an instruction indicating that goods, to which the second identifier is attached, have been delivered to a retail store, the goods being obtained by referencing the part of the transaction information and being sold in the transaction; (Column 11, lines 18-49)

accepting the first identifier received by a buyer and the second identifier attached to the delivered goods and checking to see if there is a correspondence between the first and second identifiers; (Figure 8B)

outputting an instruction allowing the delivered goods to be passed to the buyer if there is the correspondence. (Figure 8B)

Walker et al ('772) does not explicitly disclose assigning a first identifier to transaction buyer and delivering the goods to a buyer; and sending the first identifier to said buyer's terminal Hogan et al. ('046) discloses assigning a first identifier to transaction buyer and delivering the goods to a buyer; and sending the first identifier to said buyer's terminal (Figure 3). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al ('772) method with the Hogan. ('046) program in order to keep a persistent record of unique customers for profiling purposes.

As per claim 9,

Walker et al ('772) discloses a transaction apparatus comprising:

means for sending a second identifier associated with the first identifier and a part of the transaction information to vendor's terminal; (Column 11, lines 7-17)

means for sending a notification to said buyer's terminal in response to an instruction indicating that goods to which the second identifier is attached, have been delivered to a retail store, the goods being obtained by referencing the part of the transaction information and being sold in the transaction; (Column 11, lines 18-49)

means for accepting the first identifier received by a buyer and the second identifier attached to the delivered goods and checking to see there is a correspondence between the first and second identifiers; (figure 8B)

means for outputting an instruction allowing the delivered goods to be passed to the buyer correspondence. (figure 8B)

Walker et al ('772) does not explicitly disclose means for assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; means for sending the first identifier to said buyer's terminal Hogan et al. ('046) discloses means for assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; means for sending the first identifier to said buyer's terminal (Figure 3). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al ('772) method with the

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Hogan. ('046) program in order to keep a persistent record of unique customers for profiling purposes.

As per claim 10,  
Walker et al ('772) discloses a transaction method comprising the steps  
sending a second identifier associated with the first identifier and a part of the transaction information to a vendor's terminal;(Column 11, lines 7-17)  
attaching, by a vendor, the second identifier to goods which is obtained by referencing the part of the transaction information and which will be sold transaction;(Column 11, lines 18-49)  
the passing the goods, via a retail store or directly, to a delivery service provider;(Figure 8B)  
searching for, by the delivery service provider, a retail store specified by a buyer and delivering the goods to the retail store;(Figure 6A)  
sending a notification to said buyer's terminal in response to the second identifier entered from a terminal at the retail store, the second identifier being attached to the goods;(Column 11, lines 18-49)  
checking to see if there is a correspondence between the first identifier recorded on a recording medium taken by a buyer and the second identifier attached to the delivered goods;(figure 8B)  
passing the delivered goods to the buyer is the correspondence.(figure 8B)  
Walker et al ('772) does not explicitly disclose assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal Hogan et al. ('046) discloses assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal. (Figure 3). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al ('772) method with the Hogan. ('046) program in order to keep a persistent record of unique customers for profiling purposes.

As per claim 11,  
Walker et al ('772) discloses a transaction method comprising the steps  
sending a second identifier associated with the first identifier and a part of the transaction information to a vendor's terminal;(Column 11, lines 7-17)  
attaching by a vendor, the second identifier to goods which is obtained by referencing the part of the transaction information and which will be sold in the transaction;(Column 11, lines 18-49)  
passing the goods, via a retail store or directly, to a delivery service provider;(Figure 8B)  
searching for, by the delivery service provider, a buyer and delivering the goods to the buyer. (Figure 6A)  
Walker et al ('772) does not explicitly disclose assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal Hogan et al. ('046) discloses assigning a first



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identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal. (Figure 3). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al ('772) method with the Hogan. ('046) program in order to keep a persistent record of unique customers for profiling purposes.

As per claim 26

Walker et al ('772) discloses a transaction program for use on a transaction apparatus, wherein the program causes a computer to execute the following steps comprising:

sending a second identifier associated with the first identifier and a part of the transaction information to a vendor's terminal;(Column 11, lines 18-49)

sending a notification to said buyer's terminal in response to an instruction indicating that goods, to which the second identifier is attached, have been delivered to a retail store, the goods being obtained by referencing the part of the transaction information and being sold in the transaction;(Column 11, lines 18-49)

checking to see if there is a correspondence between the identifiers upon receiving the first identifier received by a buyer and the second identifier attached to the delivered goods;(Column 11, lines 41-49)

outputting an instruction allowing the delivered goods to be passed to the buyer if there is the correspondence;(Figure 8B)

sending an instruction requesting to transfer an amount for the goods from a buyer's account to a predetermined account.(Column 11, lines 41-49)

Walker et al ('772) does not explicitly disclose assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal. Hogan et al. ('046) discloses assigning a first identifier to transaction information sent from a buyer's terminal, the transaction information relating to a transaction; sending the first identifier to said buyer's terminal. (Figure 3). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al ('772) method with the Hogan. ('046) program in order to keep a persistent record of unique customers for profiling purposes.

### ***Allowable Subject Matter***

Claims 12-25,27,28 and 30-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is

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respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

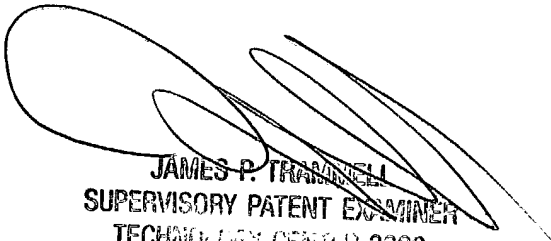
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

July 26, 2004



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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